

II. Remarks

Reconsideration and allowance of the present application are respectfully requested.

Claims 1-22 currently stand in the present application. Claim 1 is independent.

Applicant has amended Claim 1 to provide clear antecedent basis for the term "uniform pressure". Accordingly, Applicant submits that the amendments submitted herein do not add new subject matter to the present application.

In Paragraphs 1-2 of the outstanding Official Action, the Examiner rejected Claims 1-22 under 35 U.S.C. §112 (first paragraph). The Examiner was particularly concerned with the expression "moving a periphery of said stack in a direction toward a center thereof while maintaining a thickness of the stack that is substantially equal to the uniform gap".

This rejection is traversed. Reconsideration is requested in light of the following remarks.

The essence of the Examiner's position appears to be that the language noted above is considered new matter since there is "no mention of the movement of the periphery of the edge of the assembly toward the centre of the assembly" and that "the drawings are merely schematic and one cannot derive exact relationships from same without having expressly stated the drawings were to scale and that their intent was to provide exact measures of what was transpiring". Applicant disagrees with this position.

More specifically, Applicant submits it is not necessary to provide the "mention" referred to by the Examiner when the claimed feature is clearly depicted in the drawings. In this regard, it is noted that, to substantiate prior art rejections later in the outstanding Official Action, the Examiner states that the failure by a prior art reference to show a restraining means is not important since a person of ordinary skill in the art would readily recognize that the metal laminate has moved toward the centre as such is "intrinsic in the operation".

Applicant submits the Examiner cannot have it both ways. The moving step referred to in Claim 1 is clearly depicted in the transition from Figures 2 through 4 of the present application. Note that gap 38 in Figure 3 is uniform and the thickness of the composite material (and each element thereof) is uniform through Figures 2 through 4. It is clearly shown and would be clearly understood by a person of ordinary skill in the art that the periphery of the stack shown in Figure 2 has been moved inwardly during the transition to Figures 3 and 4.

The Examiner is requested to reconsider and withdraw the rejections raised in Paragraphs 1-4 of the outstanding Official Action.

In Paragraphs 4-5 and 8 of the outstanding Official Action, the Examiner raises prior art rejections under 35 U.S.C. §103(a).

First, the Examiner rejects Claims 1-22 under 35 U.S.C. §103(a) as being purportedly unpatentable over "either" of United States patent 5,985,457 [Clifford] or International Publication Number WO 00/48831 [Dion] "and any of" Japanese patent 11-151530, Japanese patent 11-347642 or United States patent 6,032,504 [Onat et al. (Onat)] "optionally further taken with" either one of Japanese patent 58-252216 or United States patent 5,152,047

[Kojimia et al. (Kojimia)]. This rejection is traversed. Reconsideration is requested in light of the following remarks.

Initially, Applicant wishes to state that the rejection raised by the Examiner in Paragraph 4 of the outstanding Official Action is not clearly stated. Specifically, it is not clear how the Examiner can reject Claims 1-22 over Clifford "or" Dion "and any one of" the two Japanese references or Onat "optionally further taken with" the third Japanese reference or Kojima. The Examiner is requested to clearly state the rejection so that Applicant can make a complete reply. Notwithstanding this, Applicant will reply to the rejection as best as it can be understood.

With regard to Clifford and Dion, Applicant offers the following remarks.

Applicant has stated previously that Dion is not a reference citable under 35 U.S.C. §103(a). The Examiner has not answered this argument about Dion.

Notwithstanding this, Applicant submits that neither Clifford nor Dion are relevant to the subject matter of the process defined by Claim 1 of the present application.

With reference to Clifford and Dion, the only justification provided by the Examiner for the rejection is that "both references did elude [*sic*] to the use of the assemblies as vehicle body parts". The Examiner transitions from this vague reference to vehicle body parts (a product) to the position that it would have been obvious to arrive at a process to form such vehicle body parts using the teachings of the two Japanese patent references or Onat. Applicant submits that the Examiner has clearly failed to establish a prima facie case of obviousness.

It is well established that, in order to sustain a rejection under 35 U.S.C. §103, it is the burden of the USPTO to establish a *prima facie* case of obviousness, In re Reuter, 651 F.2d 751, 210 U.S.P.Q. 249 (CCPA 1981). In asserting such a case of obviousness, the Examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention. In this regard, the teachings of a single prior art reference or a primary prior art reference (which is combined with one or more secondary prior art references) must be sufficient to justify a conclusion that any proposed modification or combination of references is what one of ordinary skill in the art would have found obvious to do at the time the invention was made, In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Moreover, the Courts have held that there must be some logical reason apparent from the evidence of record that would justify a modification or combination of prior art references, In re Regel, 188 U.S.P.Q. 132 (CCPA 1975). If there is no such reason, the *prima facie* case of obviousness has not been made out, Oscar Mayer Foods Corp. v. Sara Lee Corp., 15 U.S.P.Q. (2d) 1204, (D.C. Wis., 1990).

Hindsight combination of references is not a valid basis for rejection under 35 U.S.C. §103, In re Adams, 148 U.S.P.Q. 742 (CCPA 1966) and In re Skoll, 187 U.S.P.Q. 481, 484 (CCPA 1975). Further, in Twin Disc Inc. v. United States, 10 Cl. Ct. 713; 231 U.S.P.Q. 417, 425 (Cl. Ct. 1986), the Court stated:

" ... it is now clear beyond cavil that it is not permissible to ascertain factually what the inventors did and then view the prior art in such a manner as to select from the random facts of that art

only those which may be modified and then utilized to reconstruct the claimed invention."

Citing Orthopedic Equipment Co., Inc. v. United States, 702 F.2d 1005, 1012; 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983), the Court in Twin Disc further stated that it is incorrect to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.

In the present situation, there is no reasonable suggestion in either Clifford or Dion to transition from the teaching of a "product" to a specific series of process steps to produce that product. For example, it would be equally plausible from the teachings of Clifford or Dion to preshape each component of the composite layers of the product and simply adhere or otherwise secure the components together to make the final product. Absent impermissible hindsight, there is no suggestion in Clifford or Dion to look specifically to the teachings of the two Japanese references or Onat for a process to produce those products.

The second rejection of Claims 1-22 under 35 U.S.C. §103(a) is a repeat of the first rejection further taken with United States patent 4,080,819 [Hook et al. (Hook)] or United States patent 4,225,553 [Hirota et al. (Hirota)]. This rejection is traversed. Reconsideration is requested in light of the following remarks.

Applicant believes this rejection will fall if the Examiner is persuaded by the above arguments concerning the first rejection raised under 35 U.S.C. §103(a). In this regard, Applicant notes that the Examiner appears to rely on Hook and Hirota solely to be combined

with some or all of five other prior art references to substantiate the rejection under 35 U.S.C. §103(a).

On page 6 of the outstanding Official Action, the Examiner states his belief that Applicant "agrees with the interpretation" of the Japanese '216 and Kojima references. This is not true. The so-called "interpretation" is found in a single sentence on page 4 of the Official Action dated November 25, 2003. Specifically, the Examiner states: "more [sic] specifically, both suggested it was personally known to employ a die press to press a multi layer assembly and join the layers together". The Examiner then goes on to combine these prior art references with the teachings of Clifford or Dion neither of which provide any suggestions for a particular method or operation to produce the products described therein. To fill in this gap, the Examiner relies on either of the two Japanese references or Onat referred to above. Clearly, this amounts to hindsight reconstruction of the claim process having prior art in hand.

Applicant requests that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a).

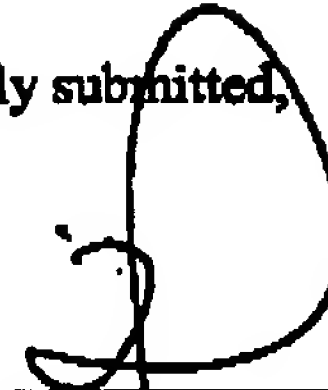
With regard to the rejection of Claims 1-22 under 35 U.S.C. §112 (second paragraph), Applicant believes this rejection is moot in light of the amendment made to Claim 1.

In light of the above, reconsideration and allowance of the present application are respectfully requested.

Applicants' undersigned agent may be reached by telephone at (416) 862-5775.

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